



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/821,919

04/12/2004

Valerie De La Poterie

05725.1266-00000

2430

22852

7590

03/09/2010

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP

901 NEW YORK AVENUE, NW  
WASHINGTON, DC 20001-4413

EXAMINER

VENKAT, JYOTHSNA A

ART UNIT

PAPER NUMBER

1619

MAIL DATE

DELIVERY MODE

03/09/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/821,919	<b>Applicant(s)</b> DE LA POTERIE, VALERIE	
	<b>Examiner</b> JYOTHSNA A. VENKAT	<b>Art Unit</b> 1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12/17/09.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-11,13,18,21,24,28,32 and 34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-11,13,18,21,24,28,32 and 34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

Receipt is acknowledged of declaration under 37 C.F.R. § 1.132 and remarks filed on 12/17/09 .

#### Status of claims

**Claims 4, 14-17, 20, 22-23, 25-27, 29-31, 33 and 36-39 are cancelled.** Claims 35 and 40 are withdrawn from consideration as being drawn to non-elected invention (election without traverse dated 11/13/07). Claims 12 and 19 are withdrawn from consideration as being drawn to non-elected species ( election without traverse dated 11/13/07 ).

Claims 1-3, 5-11, 13, 18, 21, 24, 28 and 32 and 34 are pending and currently examine din the application in the application. **Claims 1, 13, 32 and 34 are examined to the extent that it reads on the elected species “polystearyl acrylate” and gum arabic as the film forming polymer.**

#### *Claim Rejections - 35 USC § 102*

Claims 1-3, 5-11,13, 18, 21, 28 and 32 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by U. S. Patent 3,911,105.

Specification teaches the measurement for measuring thermal profile. See below.

#### **Determination of the thermal profile of the composition**

*[022] The thermal profile of the composition according to the present disclosure is determined using a differential scanning calorimeter (DSC), for example the calorimeter sold under the name DSC 30 by the company Mettler.*

**See claim 5 of patent for “elected species” polystearyl acrylate.** See col.5, ll 37-40 for water (aqueous phase of instant claim 21) and see col.4, ll 49-65 for instant claim 28 drawn to

Art Unit: 1619

dyestuff. Examples 26-28 read on instant claim 1 and remaining examples read on claims 32 and 34.

PTO is not equipped to measure the thermal profile and the limitations claimed in claims 2-3 and 5-11, are also anticipated by patent ' 105.

### ***Response to Arguments***

Applicant's arguments filed 12/17/09 have been fully considered but they are not persuasive.

Applicants' argue:

*"In the Interview, the Examiner suggested that Applicant perform additional comparative testing by preparing the composition of Example 29 of the '105 patent, but using polystearyl acrylate instead of the "homopolymer of Example 1 ." '105 patent, col. 14 line 34. The Examiner suggested that Applicant then evaluate the heat stability of such a composition.*

*In response, Applicant has performed comparative testing per the Examiner's suggestion and submit herewith a Declaration under 37 C.F.R. § 1.132 of Florence LAHOUSSE dated December 16, 2009 ("the LAHOUSSE Declaration"), describing the testing. As set forth in the LAHOUSSE Declaration, a composition according to Example 29 of the '105 patent, but using polystearyl acrylate instead of the "homopolymer of Example 1 ," was evaluated for heat stability using the procedure*

Art Unit: 1619

*described in Applicant's specification at paragraph [0156] on page 38.*

*See the LAHOUSSE Declaration at I[I] 8-10 and Table 1. The*

*LAHOUSSE Declaration shows that a composition of Example 29,*

*including polystearyl acrylate, does not possess the heat stability of claim*

*1. See id. at 111[ 14-15 and Table 2. Thus, the LAHOUSSE Declaration*

*demonstrates that the heat stability of claim 1 is not an inherent result of a*

*composition comprising polystearyl acrylate and is not anticipated by the*

*'105 patent “.*

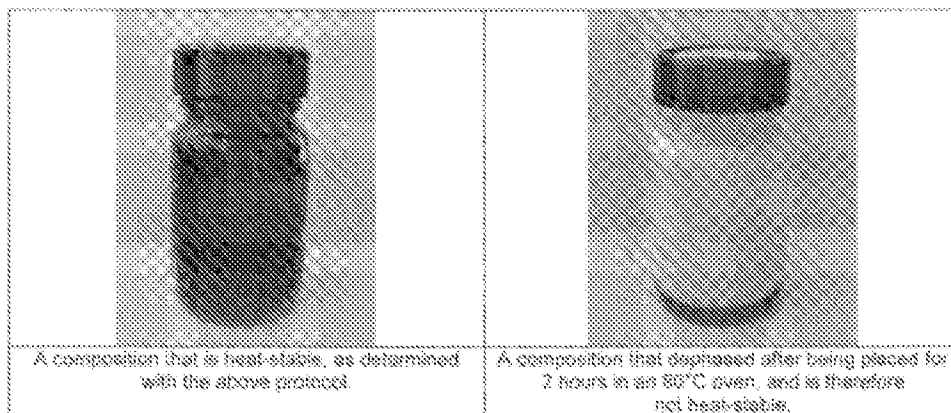
#### ***Response to Amendment***

The declaration under 37 CFR 1.132 filed 12/17/09 is insufficient to overcome the rejection of claims rejected under 102(b) based upon patent 3,911,105 ('105) as set forth in the last Office action because of the following reasons:

1. Declarant under item 14) states that the left photograph left photograph is an inventive composition, while the composition on the right is that of Example 29, after it has dephased and the evidence which shows that even if the compositions of patent '105 is modified to include the claimed elected species “ polystearyl acrylate”, the composition is not heat stable.

In response, one can not determine whether the composition on the right is dephased and the composition on the left is heat stable, since the photograph on the left is a black bottle and the one on the right is white bottle. For applicants' convenience the photographs is reproduced below:

Art Unit: 1619



2. What is the initial viscosity of example 29 tested in the declaration at  $T_0$  and what is the viscosity of example 29 after one heating cycle? Applicants' attention is drawn to [0157] of the specification which shows the initial viscosity and viscosity after one heating cycle.

Therefore the declaration submitted to show that the composition of patent '105 are not heat stable is unpersuasive.

### ***Claim Rejections - 35 USC § 103***

Claims 1-3, 5-14, 18, 21, 24, 28 and 31-34 rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 3,911,105 ('105) and 6,875,245 ('245).

Patent '105 teaches cosmetic composition using polystearyl acrylate, aqueous phase and dyestuff and use these compositions in the form of lipstick and mascara. Patent does not teach the limitation of claim 24, wherein the composition further comprising film-forming polymer, which is gum arabic (elected species). Patent '245 teaches compositions in personal care products. Personal care products are also known as cosmetic compositions. Patent '245 under

Art Unit: 1619

examples 8-9, 25 and 66 teaches mascara compositions using gum arabic. Thus both the patents teach individually mascara compositions using polystearyl acrylate and gum arabic.

Accordingly it would be obvious to one of ordinary skill in the art at the time the invention was made to prepare third composition and use it for coating keratin fibers (mascara) by combining the two components polystearyl acrylate and gum arabic with the reasonable expectation of success that the third composition is also effective for coating the keratin fibers. It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in the prior art.

### ***Response to Arguments***

Applicant's arguments filed 12/17/09 have been fully considered but they are not persuasive.

Applicants' argue:

*First, the '105 patent does not disclose or suggest that the compositions it discloses are heat-stable or that heat-stability is an objective of the '105 patent. Second, as shown in the LAHOUSSE Declaration, compositions disclosed by the '105 patent are not inherently heat stable. Nor is heat stability a predictable result of compositions that comprise polystearyl acrylate.*

*In addition, one of ordinary skill in the art at the time of the present invention would not have considered it obvious to modify the '105 patent*

Art Unit: 1619

*in an attempt to achieve a composition that was heat-stable or to achieve Applicant's claimed invention. This is at least because, as established above, the '105 patent does not disclose or suggest that any composition it discloses is heat stable. Further, in view of the LAHOUSSE Declaration, the '105 patent does not render obvious heat stability. For at least these reasons, the '105 patent does not teach or suggest Applicant's claimed invention as recited in independent claim 1.*

In response to the above argument, the evidence presented to show that the compositions of patent '105 are not heat stable is unpersuasive for the reasons stated above and the claims are prima facie obvious since patent '105 teaches all the limitations except film forming polymer (claimed species) and both the patents teaches mascara compositions and it is prima facie obvious to prepare a third composition by combining two compositions which are also used for the same purpose.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,



Art Unit: 1619

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, EYLER YVONNE (BONNIE) can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /  
Primary Examiner, Art Unit 1619